

REMARKS/ARGUMENTS

Claims 1-4, 6-16 remain in the application.

Claims 1-4 and 6-16 are rejected under 35 USC 103(a) as being unpatentable over Freeman, et al. (USPN 6,450,407) in view of Swartz, et al. (USPN 6,243,447). The grounds for the rejection are set forth in the Office Action (OA). Applicants respectfully traverse this rejection.

Applicants respectfully submit that according to MPEP §2143.03, "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Applicant respectfully submits that neither Freeman nor Swartz teach applying a store discount to a plurality of specially marked items, as is claimed in Applicant's independent claims 1, 6 and 10.

Applicant respectfully submits that Swartz fails to teach a discount being applied to a plurality of items. The OA states this at the last line of page 2.

Applicant respectfully submits that Freeman fails to teach a discount being applied to a plurality of items as well. The OA states as much at page 3, line 4, noting that the discount of Freeman is applied to a "particular product", citing column 11, lines 9-12. To be sure, Freeman teaches only the application of a discount to a particular product at the following locations:

Col. 12, lines 3-22:

The example here is paying for a single toll at a toll bridge ("The purchase may be usage of a toll road..."), in conjunction with receiving advertising information ("Information identifying the downloaded advertisement information may be downloaded onto the chip card.") This is a single purchase relating to downloaded advertising information.

Col. 11, lines 9-12:

In this passage, there is no suggestion that the Freeman invention applies to a plurality of products. The passage simply states, "The value of the rebate may be greater for frequent, loyal shoppers than for shoppers that make one-time purchases only for a short time period." This passage, cited by the OA, talks only of altering the value. There is no teaching that here that suggests applying a discount to a plurality of products.

Col. 13, lines 35-65:

In this section, Freeman states, "The tracking information related to the advertisement information may further include information indicating whether a product related to the advertisement information has been purchased using the chip card." This is a direct teaching to a one product to one downloaded advertisement system, not a discount that is applied to a plurality of products.

Col. 14, lines 35-38:

In this section, Freeman states, "The information characterizing the user comprises a user profile generated from demographic, psychographic, or other specific product preference information along with a user identification." There is no suggestion of applying a discount to a plurality of products.

Further, throughout the specification, Freeman continually teaches a one advertisement to one product discount being applied as a "rebate" (See, e.g. the title). For example, at col. 7, lines 4-7, Freeman states, "Preferably, our invention is used to deliver targeted advertisement information and to rebate the consumer for receiving that information and for purchasing the particular products associated with that information." At col. 7, lines 15-25, Freeman states, "During a purchase transaction when the chip card is used to purchase a product, the system determines whether a rebate is associated with the product being purchased, and if a rebate is associated with the product, a rebate in the form of electronic money is entered into the memory of the card during the purchase transaction. By "product" we mean either a tangible item

such as food or clothes, but also services rendered where no tangible item is transferred in the transaction." At col. 8, lines 54-56, Freeman states, "At the time a customer uses the chip card with the particular ASP to purchase the associated item..."

Additionally, throughout the application, Freeman exclusively teaches a system where advertising information or rebate information for a specific product is used. This advertising information comes from a manufacturer. See, e.g., col. 3, lines 12-30. Additionally, such a system requires a one-to-one link between the particular product and a particular "ASP" (to use the terminology of Freeman) prior to any discount being made.

As neither Freeman nor Swartz teach applying a discount to a plurality of products, Applicant respectfully submits that the combination of references fails to teach all of Applicant's claimed limitations. As such, Applicant respectfully submits that the §103 rejection is overcome, as the requirements of MPEP §2143.03 have not been met. Applicant respectfully requests reconsideration of the rejection in light of these comments.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

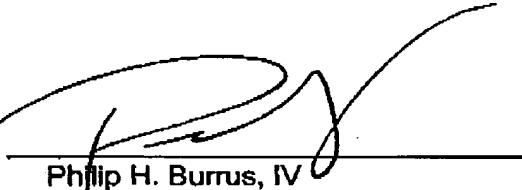
The Applicant believes that the subject application, as amended, is in condition for allowance. Such action is earnestly solicited by the Applicant.

If any matter related to this application would be more easily handled by telephone, Applicant is available by telephone at 770-338-3614. Thank you for your assistance with this application.

Respectfully submitted,

SEND CORRESPONDENCE TO:

Motorola, Inc.
Law Department
1700 Belle Meade Court
Intellectual Property
Lawrenceville, GA 30043
Customer Number: 27940

By: 

Philip H. Burrus, IV
Attorney of Record
Reg. No.: 45,432

Telephone: 770.338.3614
Fax No.: 770.338.3557